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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,019	01/11/2002	Jean-Francois Courtoy	78200-040	5197

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EXAMINER	
VO, HAI	

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/046,019	COURTOY ET AL.	
	Examiner	Art Unit	
	Hai Vo	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 September 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30,33,37-45,47,50-52,54 and 56-58* is/are pending in the application.

4a) Of the above claim(s) *1-30 and 37-45* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *33, 47, 50-52, 54, and 56-58* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. The 112 claim rejections are withdrawn in view of Applicants' arguments (see pages 18-20 of the 09/16/2005 amendment).
2. The art rejections over Brossman et al (US 6,613,256) in view of Rutsch et al (US 5,147,901) are maintained.
3. The double patenting rejections are maintained until the terminal disclaimer is submitted.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 33, 47, 50-52, 54, and 56-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brossman et al (US 6,613,256) in view of in view of Rutsch et al (US 5,147,901) substantially as set forth in the 04/29/2005 Office Action. THe art rejections have been maintained for the following reasons. Applicants argue that even if the Rutsch ink had sufficient photoinitiator and the ink was used in the Brossman product, the mechanically embossed portion of the product could not be UV cured because the wear layer of Brossman does not contain a crosslinkable photopolymer or monomer. Likewise, Applicants agree that the Brossman is properly combinable to Rutsch. However, the combined teachings of the two references do not teach the surface covering wherein the wear layer contains a cross-linkable photopolymer or monomer. Since the claims do not require the cured

coating in direct contact with the plastic layer, the topcoat of Brossman reads on Applicants' cured coating. Brossman discloses the topcoat made from a cross-linkable epoxy, melamine which reads on Applicants' cross-linkable monomer. It is true that the Brossman does not teach the topcoat is mechanically embossed with a UV cured mechanically embossed texture. However, it is a product-by-process limitation not as yet shown to produce a patentably distinct article. It is the examiner's position that the surface covering of Brossman as modified by Rutsch is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity. Brossman discloses a synthetic covering comprising a substrate 6, a foamed plastic layer overlaying 14 the substrate 6, a first ink 16 containing an expansion inhibitor on the foam layer (figure 4). Brossman teaches a polyurethane top coat 20 overlaying the foam layer and the ink wherein the portion of the cured layer disposed over the first ink is mechanically embossed with a textured surface (column 8, lines 20-25, column 1, lines 30-36). The portion of the topcoat not disposed over the first ink 16 or the foamed regions is smooth as shown in figures 3 and 4. Brossman discloses that the "foamed regions" correspond to "up areas" of the chemical embossing and the "non-foamed regions" correspond to "down areas" of the chemical embossing (column 3, lines 24-27). Likewise, the portion of the topcoat over the non-foamed regions is chemically embossed. Brossman teaches the topcoat overlying the foamed and non-foamed regions are independently predominately textured. The topcoat overlying the foamed regions is predominately

textured first and subsequently the topcoat overlying the unfoamed regions is predominately textured (column 4, lines 27-40). The mechanically embossed texture is wood, tile, brick or stone (column 1, lines 30-35). Brossman does not disclose the first ink containing a photoinitiator. Rutsch, however, teaches a printing ink used in floor coverings containing propiophenones as a photoinitiator to provide an improved stability on storage and increased resistance to yellowing (abstract, column 8, lines 14-17). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ propiophenones as a photoinitiator in the printing ink motivated by the desire to provide the printing ink having increased resistance to yellowing.

Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. ***In re Thorpe***, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. ***In re Marosi,*** 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in

scope with the claims and how the Comparative Examples are commensurate in scope with surface covering of Brossman as modified by Rutsch.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

   A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

   Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 33, 50-52, 54, and 56-58 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-57 of copending Application No. 10/321,617 substantially as set forth in the 04/29/2005 Office Action.

   This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claim 47 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-57 of copending Application No. 10/321,617 in view of Brossman et al (US 6,613,256) substantially as set forth in the 04/29/2005 Office Action.

   This is a provisional obviousness-type double patenting rejection.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hai Vo

HV

HAI VO
PRIMARY EXAMINER